

## **REMARKS**

### **I. Status of the Claims**

By this Amendment, Applicant has amended claim 15 and added new claim 70. For at least the reasons outlined below, no new matter has been added. Claims 61-69 have been withdrawn from further consideration as being directed to non-elected subject matter. Thus, claims 15-60 and 70 are pending on the merits.

Claim 15 has been amended to recite, *inter alia*, “a precipitated calcium carbonate comprising a mixture of aragonitic particle shapes and rhombohedral particle shapes in a weight ratio ranging from 40:60 to 60:40 aragonitic:rhombohedral . . . .” This subject matter is fully supported by the originally-filed application at least at page 4, lines 14-16 and 26-28, and claims 1 and 8. Support for new claim 70 may be found at least at page 11, lines 25-30, and page 12, lines 25-29. Thus, no new matter has been added by these claim amendments. Therefore, Applicant respectfully requests entry of the claim amendments and reconsideration of this application.

### **II. Claim Rejections under 35 U.S.C. § 103(a)**

#### **A. Rejection based on Wesley and Bleakley**

Claims 15-25, 28-38, 41-52, and 58-60 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,758,895 B2 to Wesley (“Wesley”) in combination with U.S. Patent No. 5,833,747 to Bleakley et al. (“Bleakley”). Office Action at 3. Claim 15 is the only independent claim included in this claim rejection. Although Applicant does not necessarily believe that this claim rejection is proper, in the interest of promoting an

expedited issuance of a Notice of Allowance for this application, Applicant has amended independent claim 15 to further distinguish it from Wesley and Bleakley. Thus, for the reasons outlined in more detail below, Applicant respectfully submits that Wesley and Bleakley, regardless of whether they are viewed individually or as a whole, fail to disclose or render *prima facie* obvious all of the subject matter recited in amended independent claim 15.

Amended independent claim 15 is directed to a pigment composition, comprising, *inter alia*, “a precipitated calcium carbonate comprising a mixture of aragonitic particle shapes and rhombohedral particle shapes in a weight ratio ranging from 40:60 to 60:40 aragonitic:rhombohedral . . . .” Neither Wesley nor Bleakley discloses or renders obvious at least this subject matter recited in amended independent claim 15.

The rejection statement concedes that Wesley fails to disclose precipitated calcium carbonate, but asserts that it would have been obvious to use a precipitated calcium carbonate having aragonitic or rhombohedral crystal structures. Office Action at 3. Applicant respectfully submits that regardless of whether Bleakley discloses precipitated calcium carbonate having aragonitic or rhombohedral particle shapes, neither Wesley nor Bleakley discloses or renders obvious the mixture of aragonitic and rhombohedral particle shapes recited in amended independent claim 15. Thus, Applicant respectfully submits that amended independent claim 15 is not *prima facie* obvious based on Wesley and Bleakley. Therefore, amended independent claim 15 is patentably distinguishable from those references, and Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 15 under 35 U.S.C.

§ 103(a) based on Wesley and Bleakley, as well as the rejection of claims 16-25, 28-38, 41-52, and 58-60, which depend from independent claim 15.

**B. Rejection based on Golley and Kosin**

Claims 15, 56, and 57 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,808,559 B2 to Golley et al. ("Golley") in combination with U.S. Patent No. 4,888,160 to Kosin et al. ("Kosin"). Office Action at 5. Claim 15 is the only independent claim included in this claim rejection, and Applicant respectfully submits that neither Golley nor Kosin discloses or renders obvious all of the subject matter recited in independent claim 15.

The claim rejection asserts that Golley discloses "a composition comprising kaolin and PCC." Id. However, the rejection statement concedes that Golley fails to disclose "that the calcium carbonate is precipitated calcium carbonate (PCC) and has a crystal structure of aragonite," but asserts that it would have been obvious "to use PCC with [a] crystal structure of aragonite, motivated by the fact that Kosin et al, also drawn to paper filler, disclose that PCC with aragonite is pure and exhibits good brightness and opacity." Id. at 6.

As outlined above, amended independent claim 15 is directed to a pigment composition, comprising, *inter alia*, "a precipitated calcium carbonate comprising a mixture of aragonitic particle shapes and rhombohedral particle shapes in a weight ratio ranging from 40:60 to 60:40 aragonitic:rhombohedral . . . ." Neither Golley nor Kosin discloses or renders *prima facie* obvious at least this subject matter recited in amended independent claim 15. Thus, Applicant respectfully submits that independent claim 15

is not *prima facie* obvious based on those references. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 15 under 35 U.S.C. § 103(a) based on Golley and Kosin, as well as claims 56 and 57, which depend from independent claim 15.

**C. Rejection based on Bleakley and Johns**

Claims 15, 30-37, 39-41, 44-46, and 51-60 were rejected under 35 U.S.C. § 103(a) based on Bleakley in combination with International Patent App. No. WO 02/165111 to Johns et al. ("Johns"). Office Action at 6. Claim 15 is the only independent claim included in this claim rejection, and Applicant respectfully submits that neither Bleakley nor Johns discloses or renders obvious all of the subject matter recited in independent claim 15. For reasons at least similar to those outlined above with respect to the § 103(a) claim rejection based on Wesley in combination with Bleakley, the combination of Bleakley and Johns fails to disclose or render *prima facie* obvious "a precipitated calcium carbonate comprising a mixture of aragonitic particle shapes and rhombohedral particle shapes in a weight ratio ranging from 40:60 to 60:40 aragonitic:rhombohedral . . . ." As outlined previously herein, Bleakley does not disclose or render *prima facie* obvious this subject matter. Moreover, Johns fails to overcome the deficiencies outlined above with respect to the § 103(a) claim rejection based on Wesely in combination with Bleakley. Thus, Applicant respectfully submits that independent claim 15 is not *prima facie* obvious based on Bleakley and Johns. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 15 under 35 U.S.C. § 103(a) based on Bleakley and

Johns, as well as claims 30-37, 39-41, 44-46, and 51-60, which depend from independent claim 15.

### III. **Rejections under 35 U.S.C. § 103(a) Limited to Dependent Claims**

Claims 26 and 27 were rejected under 35 U.S.C. § 103(a) based on Wesley in combination with Bleakley and U.S. Patent No. 6,251,356 B1 to Mathur ("Mathur"). Office Action at 4. Claims 39 and 40 were rejected under 35 U.S.C. § 103(a) based on Wesley in combination with Bleakley and U.S. Patent No. 7,048,900 B2 to Mathur et al. ("Mathur et al."). Id. Claims 53-55 were rejected under 35 U.S.C. § 103(a) based on Wesley in combination with Bleakley and U.S. Patent No. 4,492,628 to Young et al. ("Young"). Id. at 5. Claims 26, 27, 39, 40, and 53-55 depend from independent claim 15. Thus, those dependent claims should be patentably distinguishable from Wesley and Bleakley for at least the same reasons as independent claim 15. Further, Mathur, Mathur et al., and Young, regardless of whether they are viewed individually or as whole, fail to overcome the above-outlined deficiencies of the § 103(a) claim rejection based on Wesley and Bleakley. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejections of dependent claims 26, 27, 39, 40, and 53-55 under 35 U.S.C. § 103(a).

### IV. **New Independent Claim 70**

Applicant's new independent claim 70 is directed to a pigment composition including, *inter alia*, "a precipitated calcium carbonate . . . , . . . and a kaolin clay with a

shape factor greater than 25 and less than 30 and a steepness greater than or equal to about 20 and less than 30.” Applicant respectfully submits that none of the references of record discloses or renders obvious at least this subject matter recited in new independent claim 70.

Regarding Wesley, the rejection statement relating to the rejection under § 103(a) based on Wesley in combination with Bleakley asserts that Wesley “discloses a composition comprising a kaolin composition, which has a shape factor of larger than 40 and a steepness of larger than 36 . . . .” Office Action at 3. Thus, Wesley does not disclose a kaolin clay with a shape factor greater than 25 and less than 30 and a steepness greater than or equal to about 20 and less than 30,” as recited in new independent claim 70. Thus, new independent claim 70 is patentably distinguishable from Wesley.

Regarding Golley and Kosin, the rejection statement relating to the rejection under § 103(a) based on Golley in combination with Kosin asserts that “Golley et al. disclose a composition comprising . . . kaolin ha[ving] a shape factor of larger than 30 [and] a steepness of at least 30 . . . .” Office Action at 5. Thus, according to the rejection statement, Golley does not disclose a kaolin clay with a shape factor greater than 25 and less than 30 and a steepness greater than or equal to about 20 and less than 30,” as recited in new independent claim 70. Kosin relates to calcium carbonate, and thus, it does not disclose “a kaolin clay with a shape factor greater than 25 and less than 30 and a steepness greater than or equal to about 20 and less than 30.”

Therefore, Golley and Kosin fail to disclose or render *prima facie* obvious all of the subject matter recited in new independent claim 70.

Regarding Bleakley and Johns, the rejection statement relating to the rejection under § 103(a) based on Bleakley in combination with Johns indicates that “Bleakly is silent about the property as applicant set forth in claim 15,” which apparently refers the steepness and/or shape factors recited in independent claim 15. Id. at 6. The rejection statement asserts, however, that that it would have been obvious “to choose the steepness factor and shape factor as applicant set forth in the instant application, motivated by the fact that Johns, also drawn to kaolin product[], discloses that good quality paper . . . is obtained by using a kaolin composition having [a] combination of values of steepness factor larger than 32, shape factor larger than 30 and a brightness of larger than 82.” Id.

New claim 70 recites, in pertinent part, “a kaolin clay with a shape factor greater than 25 and less than 30 and a steepness greater than or equal to about 20 and less than 30.” According to the rejection statement, Bleakley fails to disclose this subject matter, and Johns discloses a steepness greater than 32 and a shape factor of larger than 30. As a result, new claim 70 is patentably distinguishable from Bleakley and Johns.

For at least the above-outlined reasons, Applicant respectfully submits that new independent claim 70 is patentably distinguishable from the references of record. Therefore, Applicant respectfully requests allowance of new independent claim 70.

#### IV. Conclusion

For at least the reasons set forth above, Applicant respectfully submits that independent claim 15 and new independent claim 70 should be allowable.

Claims 15-60 depend from allowable independent claim 15. For at least this reason, dependent claims 16-60 should be allowable. Therefore, Applicant respectfully requests reexamination of the present application, reconsideration and withdrawal of the claim rejections, and allowance of claims 15-60 and 70.

If the Examiner believes that a telephone conversation might advance prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned attorney at (404) 653-6559.


Applicant respectfully submits that the Office Action contains a number of assertions concerning the related art and the claims. Regardless of whether any of those assertions are addressed specifically herein, Applicant respectfully declines to automatically subscribe to them.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

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By:   
Christopher T. Kent  
Reg. No. 48,216